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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,342	10/05/2004	Yukihiko Taguchi	018842.1319	8373
24735 7590 11/04/2008 BAKER BOTTS LLP C/O INTELLECTUAL PROPERTY DEPARTMENT THE WARNER, SUITE 1300 1299 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004-2400				
EXAMINER WEINSTEIN, LEONARD J				
ART UNIT 3746		PAPER NUMBER		
NOTIFICATION DATE 11/04/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/510,342

Applicant(s)

TAGUCHI, YUKIHIKO

Examiner

LEONARD J. WEINSTEIN

Art Unit

3746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Devon C Kramer/
Supervisory Patent Examiner, Art Unit 3746

/Leonard J Weinstein/
Examiner, Art Unit 3746

With regards to the rejection of claims 1-4 under 35 U.S.C. 103(a) as being unpatentable under Kimura et al. US 2001/0003573 in view of Taguchi US 5,332,365, the applicant argues that the office action does not provide a reason as to why one of ordinary skill in the art would modify the control valve of Kimura by adding the partition plate 482 of Taguchi.

First the examiner notes (references to the instant application are included within () next to the corresponding references to Kimura) that the valve of Kimura is identical in almost every significant way to the valve in the instant application, with the exception that Kimura teaches a spring member 60 that biases a second plunger 44 (19) which acts to close a passage 58 (16) when an electromagnetic force generated by coil 65 is not set to where it overcomes the urging force of spring 60. When a coil 65 (22) is energized to overcome the urging force of spring 60 and spring 64, the second plunger 44 (19) is pulled down, and as shown in figure 4 which constitutes the exact same arrangement, with the exception of the partition wall, as the instant application. That is as a suction chamber 22 (67) communicates with a pressure chamber 49 (3) of a valve, a passage 58 (16) extends from the pressure chamber 49 (3) to the now formed chamber, not designated by reference (17), between element 44 (22) and valve seat element 59 (essentially element 15) that is open to a second valve chamber 47 (12). The arrangement shown in figure 4 is almost identical to that of the instant invention. In fact as can be seen from figure 4, the base 63 (25) of rod 43 (18) is displaced upwards and the top section of the larger diameter portion 43c (11) of rod 43 (18) is in abutment with element 55 (not designated in the instant application). This closes a communication path between the second valve chamber 47 (12) and port 53 (not designated) which communicates with the crank chamber 23 (66) of a variable displacement compressor. The only difference between the two arrangements is that the valve seat 59 of Kimura does not have annular section that extends inwardly from the walls that define element 47, which is provided by the partition wall (15) in the instant application. The examiner notes that the valve seat serves the exact same function of the "non-contact" partition wall (15) in defining a channel through which fluid can flow to a valve chamber 47 (12) from a chamber (17) arranged below the valve chamber 47 (12) and immediately above a second plunger 44 (19). The chamber (17) being formed (always being formed in the case of the instant application) when a second plunger 44 is disposed away from the valve seat 59 (essentially 15) and forming a second pressure chamber, not designated (17). In Kimura, element 59, when a second plunger is not resting on it, in combination with element 58 provides a passage for fluid to flow from a first pressure chamber 49 to a valve chamber 47 just as in the instant application a partition wall 15 in combination with elements 16 and 14 serves to provide a passageway between a pressure chamber 3 and a valve chamber 12.

Taguchi US 5,332,365 teaches that it was known in the art to separate chambers within a valve for a variable displacement compressor with a partition wall that forms an annular section extending inwardly from a wall that defines one of the chambers being separated. In fact the partition plate 482 of Taguchi separates a pressure chamber 483 from a valve chamber 421a within a control valve. Taguchi therefore teaches an equivalent structure for the valve seat 59 of Kimura which accomplishes the same function of separating a pressure chamber and a valve chamber within a variable displacement compressor control valve. The examiner also notes that extending or adding an annular section that extends inwardly from the inner wall of valve seat 59 would not alter the function of the valve shown in figure 4 of Kimura, or the valve seat 59 within the valve. The addition of a small inwardly extending annular section would still provide a passageway for fluid to flow through, and a valve seat that comes into abutment with a plunger when a coil is not energized so as not to overcome a spring force.

With respect to applicant's assertion that is no, and the examiner has not established, motivation to modify the control valve of Kimura to have the partition wall (plate) of Taguchi, the examiner notes that Taguchi shows that a wall extending inwardly from a vertical wall that defines one of a pressure chamber and/or a valve chamber within a control valve for a variable displacement compressor, was an equivalent structure known in the art. In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Taguchi represents evidence that an inwardly extending wall having hole through fluid can flow was an art-recognized equivalent structure for a valve seat that forms a passage through which fluid can flow when a plunger is not resting on the valve seat. Therefore, because these two fluid passage forming structures were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a partition wall for a valve seat. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).